

**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

ECOFACITOR, INC., Plaintiff, v. GOOGLE LLC, Defendant.	Case No. 6:20-cv-00075-ADA
ECOFACITOR, INC., Plaintiff, v. ECOBEE, INC., Defendant.	Case No. 6:20-cv-00078-ADA
ECOFACITOR, INC., Plaintiff, v. VIVINT, INC., Defendant.	Case No. 6:20-cv-00080-ADA

**JOINT REPORT ON NARROWING OF
ASSERTED CLAIMS AND PRIOR ART REFERENCES**

Plaintiff EcoFactor, Inc. (“EcoFactor”) and Defendants Google LLC, ecobee, Inc., and Vivint, Inc. (collectively, “Defendants”) hereby submit this Joint Report in accordance with the Court’s Standing Order Governing Proceedings – Patent Cases and the Scheduling Order entered in each of the above-captioned cases.

There are three total patents asserted in the three above-captioned cases, although some patents are not asserted against all Defendants. In its infringement expert reports, EcoFactor asserts a total of 46 claims across the three asserted patents. In their invalidity expert report, Defendants assert a total of 47 prior art theories.

On November 3, 2021, the parties met and conferred to discuss narrowing the number of asserted claims and prior art references at issue. After this meeting, the parties further corresponded regarding potential narrowing and ultimately agreed to the following:

- For every claim that EcoFactor asserts, Defendants will assert no more than two prior art theories, where a “prior art theory” is defined as either a single reference or a unique combination.
- EcoFactor will assert no more than eight claims per patent, and no more than 18 claims total. EcoFactor agrees to identify the claims that it is dropping by November 12, 2021.
- Once EcoFactor identifies the claims that it is dropping, Defendants will have seven days to identify the prior art theories that they are dropping in response.

In addition, the parties will continue to communicate with one another regarding further narrowing of asserted claims and prior art as trial approaches.

Date: November 10, 2021

Respectfully submitted,

/s/ Reza Mirzaie

Reza Mirzaie

Marc A. Fenster

Paul A. Kroeger

James N. Pickens

Kristopher R. Davis

Minna Y. Chan

Matthew Aichele

Adam S. Hoffman

RUSS AUGUST & KABAT

12424 Wilshire Boulevard 12th Floor

Los Angeles, California 90025

Tel: 310-826-7474

rak_ecofactor@raklaw.com

Attorneys for Plaintiff EcoFactor, Inc.

/s/ Robert A. Van Nest

ROBERT A. VAN NEST (admitted *Pro Hac Vice*)
LEO L. LAM (admitted *Pro Hac Vice*)
EUGENE M. PAIGE (admitted *Pro Hac Vice*)
R. ADAM LAURIDSEN (admitted *Pro Hac Vice*)
JENNIFER A. HUBER (admitted *Pro Hac Vice*)
KRISTIN HUCEK (admitted *Pro Hac Vice*)
ANNA PORTO (admitted *Pro Hac Vice*)
PATRICK E. MURRAY (admitted *Pro Hac Vice*)
GREGORY WASHINGTON (admitted *Pro Hac Vice*)
ERIC B. HANSON (admitted *Pro Hac Vice*)
633 Battery Street
San Francisco, CA 94111-1809
Telephone: 415 391 5400
Facsimile: 415 397 7188
econest-kvp@keker.com

POTTER MINTON
Michael E. Jones (TX Bar No. 10929400)
mikejones@potterminton.com
Patrick C. Clutter (TX Bar No. 24036374)
patrickclutter@potterminton.com
110 N. College, Suite 500
Tyler, Texas 75702
Tel: 903-597-8311
Fax: 903-593-0846

Shamita Etienne-Cummings
(admitted to the *Western District of Texas*)
Allen & Overy LLP
1101 New York Avenue, NW
Washington, DC 20005
Telephone: (202) 683-3810
GoogleEcofactorWDTX@AllenOvery.com

Bijal V. Vakil
(admitted to the *Western District of Texas*)
Eric Lancaster (admitted *Pro Hac Vice*)
Allen & Overy LLP
530 Lytton Avenue, 2nd Floor
Palo Alto, CA 94301
Telephone: (650) 388-1703
GoogleEcofactorWDTX@AllenOvery.com

Attorneys for Defendant GOOGLE LLC

Date: November 10, 2021

/s/ Rudolph Telscher, Jr.

Rudolph A. Telscher, Jr.

Missouri Bar No. 41072*

rudolph.telscher@huschblackwell.com

Kara R. Fussner

Missouri Bar No. 54656*

kara.fussner@huschblackwell.com

Daisy Manning

Missouri Bar No. 62134*

daisy.manning@huschblackwell.com

HUSCH BLACKWELL LLP

190 Carondelet Plaza, Suite 600

St. Louis, MO 63105

314.480.1500 Telephone

314.480.1505 Facsimile

Ryan B. Hauer

Illinois Bar No. 6320758*

ryan.hauer@huschblackwell.com

HUSCH BLACKWELL LLP

120 South Riverside Plaza, Suite 2200

Chicago, IL 60606

312.655.1500 Telephone

312.655.1501 Facsimile

*Admitted *Pro Hac Vice*

Jennifer P. Ainsworth

WILSON, ROBERTSON & CORNELIUS, P.C.

909 ESE Loop 323, Suite 400

Tyler, Texas 75701

(903) 509-5000 Main

(903) 509-5001 Direct

(903) 509-5092 Fax

Email: jainsworth@wilsonlawfirm.com

Manny J. Caixeiro

VENABLE, LLP

2049 Century Park East, Suite 2300

Los Angeles, CA 90067

310-229-9900

Fax: 310-229-9901

Email: MJCaixeiro@venable.com

Timothy J. Carroll
Vivian Sandoval
Steve M. Lubezny
VENABLE LLP
227 West Monroe Street, Suite 3950
Chicago, IL 60606
312-820-3400
Fax: 312-820-3401
Email: tjcarroll@venable.com
vsandoval@venable.com
smlubezny@venable.com

Attorneys for Defendant ecobee, Inc.

Dated: November 10, 2021

By: /s/ Fred I. Williams

Fred I. Williams
fwilliams@wsltrial.com
Williams Simons & Landis PLLC
327 Congress Ave., Ste. 490
Austin, TX 78701
Tel: 521-543-1354

Todd E. Landis
tlandis@wsltrial.com
Williams Simons & Landis PLLC
2633 McKinney Ave., Ste. 130 #366
Dallas, TX 75204
Tel: 562-543-1357

John Wittenzellner
jwittenzellner@wsltrial.com
Williams Simons & Landis PLLC
1735 Market St., Suite A #435
Philadelphia, PA 19103
Tel: 512-543-1373

Attorneys for Defendant Vivint, Inc.

CERTIFICATE OF SERVICE

I hereby certify that the counsel of record have been served electronically on November 10, 2021.

/s/ Kristopher R. Davis